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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,331	06/26/2003	David W. Deaton	026656.0332	7922
26111 7590 11/05/2007 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER SHAH, AMEE A	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 11/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/609,331	Applicant(s) DEATON ET AL.	
	Examiner Amea A. Shah	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,96 and 97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,96 and 97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/12/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-20, 96 and 97 are pending in this action.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

Claims 1-6, 11, 16, 17, 96 and 97 are rejected under 35 U.S.C. §102(e) as being unpatentable over Reuhl et al., US 5,873,069, cited by Applicant (hereafter referred to as “Reuhl”) in view of Christianson et al., 6,102,969 (hereafter referred to as “Christianson”).

Referring to claim 1. Reuhl teaches a method for use in marketing, comprising:

- detecting, at a remote computer, product purchase information of a plurality of stores, the product purchase information including price information, the remote computer located remote from the stores (col. 3, lines 18-28, col. 8, lines 64-68 and col. 10, lines 15-32 – note that the product purchase information is detected “enterprise-wide (e.g. a retailer with many locations in many market areas),” as well as from competitors, thereby comprising a plurality of retail stores);
- receiving, at the remote computer, a shopping list of a customer, the shopping list including at least one item (col. 10, lines 54-61 – note the shopping list of at least one item is the entering of product identification code by the user); and
- in response to receiving the shopping list initiating communication, to the customer by the remote computer, of price information associated with the at least one item on the shopping list for the plurality of stores (Fig. 8 and col. 11, lines 11-23 – note the price information is displayed as the result of the search).

While Reuhl teaches detecting product purchase information including price information by searching a database once prices are inputted (col. 16, lines 5-27), it does not specifically show detecting the price information from a plurality of different retailers from points-of-sale associated with the respective retailers. However, Christianson, in the same field of endeavor and/or pertaining to the same issue, teaches the use of "shopbots" for detecting product purchase information, including price information, of a plurality of different retailers from points-of-sale associated with the respective retailers (Fig. 2A and col. 6, lines 14-42 - note that the "shopbot," similar to a web-crawler, detects price information from various retailer websites, i.e. points-of-sale, by querying and receiving responses through a remote computer).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of a shopbot for detecting price information from a plurality of retailers from points-of-sale associated with the retailers, as taught by Christianson, with the known elements of receiving price information, received a shopping list and communicating price information associated with the list, as taught by Reuhl, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Reuhl and Christianson would yield the predictable results of retrieving relevant data as quickly as possible, as suggested by Christianson (col. 2, lines 53-66).

Referring to claim 2. Reuhl and Christianson further teach the method of claim 1 wherein initiating communication comprises transmitting an electronic mail message for receipt

by the customer (Reuhl, col. 11, lines 11-23 – note the electronic mail message is the display presented to the customer).

Referring to claim 3. Reuhl and Christianson further teach the method of claim 1 wherein the detecting of product purchase information of a plurality of retailers occurs on a substantially real-time basis (Christianson, col. 2, lines 61-66 - note that the bit works fast, i.e. on a substantially real-time basis). One ordinary skill in the art would have recognized that the combination of Reuhl and Christianson would yield the predictable results of retrieving relevant data as quickly as possible, as suggested by Christianson (col. 2, lines 53-66).

Referring to claim 4. Reuhl and Christianson further teach the method of claim 1 wherein receiving a shopping list of a customer comprises receiving an electronic mail message including the at least one item (Reuhl, col. 11, lines 2-10 – note the message includes the product identification of the item).

Referring to claims 5 and 6. Reuhl and Christianson further teach the method of claim 1 wherein receiving a shopping list of a customer comprises receiving information from the customer over the Internet by receiving information inputted into a web page associated with the remote computer (Christianson, Fig. 2A and col. 6, lines 7-13). One ordinary skill in the art would have recognized that the combination of Reuhl and Christianson would yield the predictable results of retrieving relevant data as quickly as possible, as suggested by Christianson (col. 2, lines 53-66).

Referring to claim 11. Reuhl and Christianson also teach the method of claim 1 further comprising initiating, by the remote computer, communication of an incentive associated with the at least one item to the customer in response to receiving the shopping list (Reuhl, col. 11, lines 11-24 – note the incentive is the value added promotion being offered).

Referring to claim 16. Reuhl and Christianson also teach the method of claim 11 further comprising comparing, by the computer, the price of the at least one item at a first retailer of the plurality of retailers to the lowest price at which the at least one item was purchased from the first retailer within a predetermine time period, the lowest price determined from the product purchase information, and wherein the incentive comprises a discount sufficient to lower the effective price at the first retail store on the at least one item to match or beat the lowest price (Reuhl, Fig. 10, col. 10, lines 27-31 and col. 12, lines 8-27).

Referring to claim 17. Reuhl and Christianson further teach the method of claim 16 wherein the predetermined time period is approximately one hour from the receipt of the shopping list (Reuhl, col. 10, lines 27-31 – note that with the predetermined price frequencies, a price request, i.e. shopping list, may be received close to one hour from the pricing time).

Referring to claims 96 and 97. All of the limitations in apparatus claims 96 and 97 are closely parallel to the limitations of method claim 1, analyzed above and are rejected on the same bases.

Claims 7-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl and Christianson in view of Herz et al., US 2001/0014868 (hereafter referred to as “Herz”).

Referring to claim 7. Reuhl and Christianson teach the method of claim 1, as discussed above, but do not specifically disclose storing product purchase information from the plurality of retail stores in association with customer identification numbers. Herz, in the same field of endeavor and/or pertaining to the same issue, discloses a method and system for customizing prices and promotions tailored to individual shoppers or types of shoppers including storing product purchase information from the plurality of retail stores in association with customer identification numbers (Fig. 1 and ¶¶0024 and 0029-0035 – note the customer identification number is the identity of the shopper).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of storing product purchase information from the plurality of retail stores in association with customer identification numbers, as taught by Herz, with the known elements of detecting prices, receiving a list and displaying prices relating to the list, as taught by Reuhl and Christianson, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Reuhl, Christianson and Herz would yield the predictable results of allowing for the tracking of product purchase information for each identified customer or type of customer, which may then be used for further marketing analysis and/or in providing more targeted offers reducing costs, improving accuracy and saving time, as suggested by Herz (¶0037).

Referring to claims 8-10. Reuhl, Christianson and Herz also teach the method of claim 7 further comprising transmitting to the customer a proposed shopping list prior to receiving the shopping list including at least one item and products previously purchased by the customer in the customer's most recent shopping transaction with one of the retail store wherein the proposed shopping list comprises products previously purchased by the customer (Herz, ¶¶0262, 0298-0303 and 0315). One ordinary skill in the art would have recognized that the combination of Reuhl, Christianson and Herz would yield the predictable results of maximizing profit by selecting promotions, including suggested shopping lists, based on purchase history so as to increase the likelihood of a customer purchase, as suggested by Herz (¶¶0262 and 0298).

Claims 12-15 and 18-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl in view of Christianson and further in view of Official Notice, as admitted by applicant to be prior art.

Referring to claims 12, 13 and 18-20. Reuhl and Christianson teach the method of claim 11, as discussed above, but does not specifically teach the incentive comprising a discount on the at least one item, or a discount on a product competitive with the at least one item. However, official notice is taken that using such types of incentives as a discount on the at least one item and a discount on a product competitive with the at least one item was old and well known in the art at the time of the invention. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have incorporated such incentives into the incentives provided in the method of Reuhl. One of ordinary skill in the art would have been motivated to

do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would allow for the customer to ensure that the prices are the most recent and reflect the latest changes made by the stores, thus improving the accuracy of the method and increasing customer satisfaction.

Referring to claim 14. Reuhl, Christianson and Official Notice teach the method of claim 13 and further comprising comparing, by the computer, the price of the at least one item at a first one of the plurality of retail stores to the price of the competitive item at the first retail store, the price of the at least one item and the competitive item at the first retail store determined from the product purchase information (Reuhl, Fig. 10 and col. 12, lines 8-27), and wherein the incentive comprises a discount sufficient to lower the effective price on the competitive item to match or beat the price of the at least one item (Reuhl, Fig. 10, col. 7, lines 17-21 and col. 11, line 64 through col. 12, line 27).

Referring to claim 15. Reuhl, Christianson and Official Notice further teach the method of claim 13 wherein the price of the competitive item comprises the price at which the competitive item was purchased within an hour of the receipt of the shopping list (Reuhl, col. 10, lines 27-31 – note that the predetermined price frequencies may be within one hour of the receipt of the list).

Response to Amendment

Applicant's amendment, filed August 18, 2007, has been entered. Claims 1, 3, 7, 10, 14, 16, 96 and 97 have been amended. In view of the amendments to the claims, the 35 U.S.C. §112 rejections to claims 14, 16 and 17 are withdrawn. In view of the amendments to the specification, the objections to the drawings are withdrawn.

Response to Arguments

Applicant's arguments, see Remarks, filed August 18, 2007, with respect to claims 8-10 not being indefinite (Remarks, pages 11-12) have been fully considered and are persuasive. The 35 U.S.C. §112 rejections of claims 8-10 are withdrawn.

Applicant's arguments with respect to claim 1 regarding Reuhl have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments regarding claims 12-15 and 18-20 (Remarks, page 16) have been considered but are not persuasive. Applicant argues generally that Official Notice does not provide the teachings missing from Reuhl that applicant pointed out earlier in the Remarks. However, Applicant does not dispute that it is old and well known in the art to use such types of incentives as a discount on the at least one item and a discount on a product competitive with the at least one item. Therefore, using discounts as incentives is considered admitted as prior art.

Conclusion

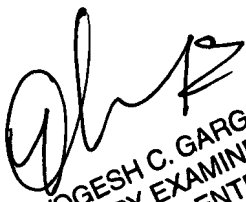
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

October 30, 2007


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